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EXAMINER

CIRIC, LJILJANA V

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 04/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/786,584

Applicant(s)

Rylewski

Examiner

Ljiljana V. Ciric *AVC*

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 28, 2003
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Apr 16, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Jan 28, 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 14 6) ☐ Other:

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## **DETAILED ACTION**

### ***Response to Amendment***

1. Receipt and entry of the amendment filed on January 28, 2003 is hereby acknowledged.
2. New claims 12 through 22 remain in the application.
3. The amendment filed on January 28, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows, for example: the heat exchanger unit comprising a box with substantially rigid walls as now recited in new claim 12, from which all of the remaining claims depend; and, the heat exchange unit comprising an on/off controller for each entry fan and for each extraction fan (i.e., separate on/off controllers for each fan) as now recited in new claim 22.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Response to Arguments***

4. Applicant's arguments filed on January 28, 2003 have been fully considered but they are not persuasive.

As a preface to the following traversal of applicant's arguments, the examiner hereby notes that the claims in a pending application should be given their *broadest* reasonable interpretation.

See In re Pearson, 181 USPQ 641 (CCPA 1974).

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In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the box being provided with substantially *rigid* walls defining fluid passages; the foil being *easily* removable *for cleaning and subsequent replacement*) are not recited in the previously rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, as noted below in greater detail in the section corresponding to rejections of the claims under 35 U.S.C. 112, first paragraph, there appears to be no support in the originally filed disclosure for now claiming that the walls of the box are "substantially rigid"; thus, applicant's arguments rely on a feature that not only had not been claimed, but furthermore, on one which had not even been originally disclosed by the instant application.

With regard to applicant's arguments regarding the removability of the thin flexible foil of the instant invention, the examiner hereby notes that all elements are inherently removable, at least to some degree. Or, put another way, the mere fact that a given structure is integral does not preclude its consisting of various elements. See *Nerwin v. Erlichman*, 168 USPQ 177, 179 (PTO Bd. Of Int. 1969). In fact, the instant application suggests that the inherent properties of the foil (i.e., its light weight and flexibility), and not the shape or form of any particular structural elements of the instant invention, render it easily removable and replaceable. See page 2, lines 19-21, of the instant application. Thus, if a prior art reference discloses a heat exchanger

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as being made of a light-weight foil like that of the instant invention, it holds that the foil heat exchanger of the prior art invention is similarly easy to remove and replace.

***Oath/Declaration***

5. Receipt and entry of the replacement declaration is hereby acknowledged.

***Drawings***

6. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on January 28, 2003 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure, while providing for plural fans and heat exchangers per se, does not support the showing of the particular configuration and physical interrelationships between the various fans and heat exchangers as now shown in new Figure 12.

7. The drawings filed on April 16, 2001 are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the features canceled from the claims: the two heat exchangers, each having a flexible foil, associated respectively with each of the two extraction fans as cited in claim 20 and claims 21 and 22 depending therefrom. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

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8. Receipt and entry of the amended abstract is hereby acknowledged.
9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there is no clear antecedent basis in the originally filed specification for the recitation of the term “on/off controller” as recited in claim 22.

***Claim Objections***

10. Claims 16 through 22 are objected to because of the following informalities: “the box is” [claim 16, line 1] should be replaced with “the box has”; “extend in a direction of a length of the box” [claim 16, line 3] should be replaced with “extend along the length of the box”; “the steam of stale air” [claim 18, line 3] should be replaced with “the stream of stale air”; “is two extraction fans” [claim 19, line 2] should be “comprises two extraction fans”. Appropriate correction is required.

***Claim Rejections - 35 U.S.C. § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
12. Claims 12 through 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While the originally filed disclosure does provide for the heat

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exchange unit including a box, there is nothing in the originally filed disclosure which describes or suggests the walls of this box as being substantially rigid as now recited in new base claim 12.

While the originally filed disclosure does provide for a fan control panel 52 as described on page 8 and as shown in Figure 1, there is nothing in the originally filed disclosure to support a claim of the heat exchange unit comprising an on/off controller for each entry fan and for each extraction fan (i.e., separate on/off controllers for each fan). Thus, the corresponding limitations in new claims 12 through 22 represent new matter.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 12 through 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to base claim 12 as written, the limitations “including a stream of fresh air obtained from outside the building and a stream of stale air from inside the building” are not clearly presented with regard to the scope of protection sought by claim 12 and all claims depending therefrom. First of all, are the streams of fresh air and stale air being positively recited by the claims? Second of all, are the air streams included in the air circulator or in the fluid passages?

With regard to claim 16 as written, the limitations “have generatrices which are substantially parallel and extend in a direction of a length of the box” are not clear and do not

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clearly correspond to a particular structure. Other than the awkward grammatical construction of these limitations (as previously objected to above), it is not clear relative to which element(s) the generatrices are parallel; more precisely, it is not clear whether the generatrices are parallel to each other or to an element of the box, for example.

With regard to claim 21 as written, it is not clear what particular structural relationship is encompassed by the limitation "comprising two heat exchangers associated respectively with the two extraction fans, each heat exchanger having a flexible foil" as recited in line 2 of the claim. First of all, it is not clear whether or not the two recited heat exchangers in addition to the fluid passage structure recited in base claim 1. Second of all, it is not clear what structural relationships are included and which ones are excluded by the term "associated...with". Finally, it is not clear whether or not the flexible foil refers to the same element as the flexible foil recited in line 7 of base claim 1 from which claim 21 ultimately depends.

*Claim Rejections - 35 U.S.C. § 102*

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. As best can be understood in view of the indefiniteness of the claims, claims 12 through 14, and 16 through 18 are rejected under 35 U.S.C. 102(b) as being anticipated by *Oberschmid (DE 40 07 963 A1--of record)*.



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*Oberschmid (DE 40 07 963 A1)*, especially Figure 3, discloses a heat exchange unit essentially as claimed, including: a box having substantially rigid heat exchanger walls 1 as shown in Figure 3 [which is associated with Figures 2a and 2b, as well as claim 13 of the reference] defining two fluid passages 3 and 4 having a cross section of undulating shape along the length of the heat exchanger box as shown in Figures 2a and 3, the walls bounding the fluid passages including a removable thin flexible foil which is air-tight and impermeable to water vapor; and, an air circulator including at least one entry fan 10 and at least one extraction fan 11. Turning an apparatus on its end and thus changing the relative orientation of its elements, such as from horizontally-oriented to vertically-oriented, does not change the structure of the apparatus and is irrelevant.

The reference thus reads on the claims.

17. Alternately for claims 12, 13, 16, and 17, and as best can be understood in view of the indefiniteness of the claims, claims 12, 13, 15 through 17 are rejected under 35 U.S.C. 102(b) as being anticipated by *Harrison (of record)*.

*Harrison* discloses a heat exchange unit essentially as claimed, including: a box or mounting member 14 having substantially rigid walls as shown in Figure 2 defining two fluid passages having a cross section of undulating shape along the length of the heat exchanger box 14, the walls bounding the fluid passages including a removable paper “foil” which is water-permeable [see the abstract of the reference]; and, an air circulator or fan 20. The paper “foil” is inherently air-tight. Turning an apparatus on its end and thus changing the relative orientation of

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its elements, such as from horizontally-oriented to vertically-oriented, does not change the structure of the apparatus and is irrelevant.

The reference thus reads on the claims.

***Claim Rejections - 35 U.S.C. § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. As best can be understood in view of the indefiniteness of the claims, claims 19 through 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Oberschmid* (DE 40 07 963 A1--of record).

*Oberschmid* (DE 40 07 963 A1--of record) discloses a heat exchange unit essentially as claimed, as noted in greater detail above, but does not necessarily disclose either the location of the fans as being exactly as recited in claim 19 of the instant application, for example, or there being two extraction fans 11 instead of one or there being two heat exchangers instead of one. Nevertheless, shifting the location of parts, absent unexpected results, and duplicating parts for a multiplied effect are matters of design choice and are thus not inventive. See *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8, 11 (7th Cir. 1977) and *In re Japikse*, 86 USPQ 70 (CCPA 1950). While *Oberschmid* also does not necessarily disclose each fan as having an on/off

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controller, Official Notice is hereby taken that it is notoriously well-known in the fan art to have fans with individual on/off controllers.

Thus, it would have been obvious to one skilled in the art at the time of invention to modify the heat exchange unit of *Oberschmid* by shifting the locations of the fans in order to effect particular flow patterns or conform with particular space requirements for a given application and/or by duplicating the number of heat exchangers and/or fans within the unit in order to double the amount of airflow and/or heat exchange effected thereby.

#### ***Conclusion***

20. The additional prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Rosenfeld et al.* discloses a flexible heat pipe.

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925. While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett, can be reached on (703) 308-0101. The fax phone number is (703) 305-3463.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

April 7, 2003



LJILJANA V. CIRIC  
PRIMARY EXAMINER  
ART UNIT 3743